

Remarks

By the above amendment, withdrawn claims 1-14 and 17-27 have been canceled without prejudice or disclaimer. Claims 15 and 16 have been amended to more particularly define the protease (as further discussed below) and to correct minor spelling and idiomatic informalities, as supported by original claims 15 and 16 and the specification, e.g., at pages 23 and 49. Claim 28 has been added to provide further coverage for an embodiment described at page 49 of the specification. The title has been amended to better reflect the claimed subject matter.

In the outstanding Office Action, the Examiner required restriction to one of the following groups: (I) claims 6 and 9; (II) claims 12 and 13; (III) claims 15 and 16; (IV) claims 17, 18, and 20; (V) claims 17, 19, and 20; (VI) claims 23, 24, and 27; and (VII) claims 25 and 26. Applicant hereby affirms the election of Group III, claims 15 and 16. This election is without traverse. Accordingly, the non-elected claims have been canceled, and Applicant reserves the right to pursue such claims in one or more divisional applications.

With respect to the elected claims, the Examiner rejected claims 15 and 16 under 35 U.S.C. § 112, first paragraph, on two grounds, namely: (i) as containing subject matter not described in the specification as reasonably conveying that the inventors had possession of the claimed subject matter; and (ii) as lacking enablement for the full scope of the claimed subject matter. From the arguments provided in the Office Action in support of both grounds of rejection, the Examiner does not appear to question that the specification demonstrates the inventors' possession of, and enables, a method for identifying compounds that modulate a serine protease C-E containing a catalytic domain corresponding to SEQ ID NO:8. Since independent claim 15 has now been written to more particularly define the protease as containing the catalytic domain corresponding to SEQ ID NO:8, the rejections under the first paragraph of Section 112 have been overcome.

Claims 15 and 16 were also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to the recitation of "protease C-E protein activity". These claims have been amended to remove the superfluous references to "protein". Applicant therefore requests the Examiner to withdraw the rejection for indefiniteness.

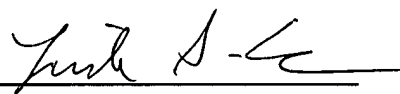
Claims 15 and 16 also stand rejected on various prior-art grounds. Specifically, the Examiner rejected claim 15 under 35 U.S.C. § 102(a) as being anticipated by Botstein et al. (WO 99/35170). Additionally, claims 15 and 16 were rejected, as understood by the undersigned, as lacking novelty based on Chen et al. (WO 99/14328) and as being obvious based on Chen et al. in view of Egelrud et al. (US 5,834,290). Furthermore, as understood by the undersigned, claims 15 and 16 were rejected as being anticipated by Antalis et al. (WO 98/36054) or as being obvious based on Antalis et al. in view of Egelrud et al. Moreover, claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Botstein et al. in view of Egelrud et al. These rejections are respectfully traversed.

The disclosures of none of the Botstein et al., Chen et al., and Antalis et al. references, alone or coupled with the Egelrud et al. reference, teaches or suggests the presently claimed invention as a whole. None of the references teaches or suggests a method for identifying modulators of serine protease C-E comprising a catalytic domain amino acid sequence as set forth in SEQ ID NO:8 as defined by the claims. Accordingly, the present claims patentably define over the prior art.

In view of the foregoing, Applicant respectfully requests allowance of the pending claims.

Respectfully submitted,

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